

C) REMARKS

The Examiner rejected claims 2 through 13 and 15 through 20 under 35 U.S.C. §112 ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded by the applicant as the invention.

The Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the Examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the Examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the Examiner might desire.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function

required by 35 U.S.C. 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q. 2d 1279, 1283 (Fed. Cir. 2000).

It is only when the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 U.S.P.Q. 2d 1190, 1195 (Fed. Cir. 1993).

Regarding claim 2, there is no requirement that the claims describe the specific structural and functional relationship between the mixer and the rest of the recited parts. However, a person reasonably skilled in the art of building musical instruments or in musical composition understands that a mixer is an electronic device for combining one or more audio signals together. Structurally, the mixer can be anywhere on the base, as referred to in the claim and specification. Additionally, as is well known in the art, faders are simply variable attenuators, or volume controls permitting the user to regulate the exact volume of each audio signal combined in the mixer. In spite of the above, claim 2 has been amended to include the functions of the mixer and fader.

Regarding claim 3, MIDI refers to a Musical Instrument Digital Interface as discussed in the specification. Functionally, as a practitioner reasonably skilled in the art would understand, a MIDI enables synthesizers, sequencers, computers, rhythm machines, etc. to be interconnected through a standard interface. Structurally, and as articulated in the claim, the MIDI can be anywhere on the base but is most likely positioned where it is most accessible to the performer. In spite of the above, claim 3 has also been amended to include the function of the MIDI.

With regard to claims 4 and 15, outboard MIDI sound devices are simply electronic instruments played separately from that of the present invention, but whose signal can be processed and played through the mixer. Therefore, the sounds of multiple instruments can be combined by the main output mixer referred to in claim 2 and their respective volumes controlled by the faders of claim 2.

With regard to claim 5, as is well known in the art, the function of a tuning meter is to make sure that the musical artist is playing in tune. Structurally, the tuning meter is illuminated because artists frequently play in dark places. Additionally, and as noted in claim 5, the tuner can be mounted anywhere in the base of the instrument as long as it can be used by the artist. The applicant respectfully suggests that the function and structure of a tuning meter is known to those persons reasonably skilled in musical performance, musical composition, or musical instrument construction.

Lastly, with regard to claims 10 and 19, the function of an electromagnetic bowing device is to provide endless touch-on/touch-off sustain of notes and chords, as noted in the specification and known to anyone reasonably skilled in the art. Structurally, the bowing devices are located underneath the strings of the instrument as shown in FIG. 1.

Only this applicant had the ingenuity, musical talent and creative flair to design this novel and unique musical instrument. Only this applicant had resolve to apply his knowledge of music and creative talents in musical instrument construction to accomplish the intended result. For his contribution, he is entitled to a patent. Reconsideration is respectfully requested.

Respectfully submitted,
James Bartz,

By



Joseph S. Helno
Reg. No. 31,524
DAVIS & KUELTHAU, s.c.
111 E. Kilbourn Ave., Ste. 1400
Milwaukee, WI 53202-1633
(414) 225-1452

Patrick M. Bergin
Provisional Reg. No. P54,994
111 E. Kilbourn Ave., Ste. 1400
Milwaukee, WI 53202-1633
(414) 225-7563